APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,246	01/18/2001	Jonathan Lowthert	INTL-0510-US (P10479)	8160

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EXAMINER
RAMAN, USHA

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 September 2006</u>.

2a)☐ This action is **FINAL.** 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28 and 30-34* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28 and 30-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

September 25th, 2006 has been entered.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 2, and 6,have been considered but

are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-28 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Picco et al. (U.S. Patent No. 6,029,045) in view of Khoo et al. (US Pre Grant

Pub. 2002/0152465) and Thomas et al. (US PG Pub. 2003/0037068)

Regarding Claim 1, Picco discloses a method comprising allowing the use of

content (Col. 4, Lines 51-54) on a content receiver (See Figure 4 and Col. 5, Lines

10-16), collecting information about a characteristic of the receiver (Col. 6, Lines 34-37, Col. 10, Lines 58-62 and Col. 11, Lines 9-13) and providing that information to a remote processor-based system (Col. 7, Lines 6-26). The information is used to select, from an advertising database (Col. 6, Line 57 - Col. 7, Line 6), an advertising subset that is based on the characteristic of the receiver (Col. 7, Lines 28-32). The receiver receives the advertising subset and selectively chooses Ads from the subset for storage (Col. 7, Lines 35-61 and Col. 8, Lines 7-16) and automatically interrupts the use of content to temporarily replace the content with an advertisement (Col. 6, Lines 23-31 and Col. 8, Lines 19-39)

Picco teaches the step of collecting characteristic about the user preferences at the receiver and is silent about obtaining a subset listing of advertising resources and guidelines for distributing advertising materials on the receiver, wherein the advertisements are chosen from the listing based on the characteristic of the receiver, stored on the receiver and played upon interrupting a media content in response to detecting a pause in content.

Khoo further discloses the step of a database of advertising resources generating a customized media listing of advertising resources and guidelines (i.e. customization derived from user's personal profile) for distributing advertising materials on the receiver. Khoo further teaches the step of downloading the media files indicated in the listing for subsequent presentation to the user. See abstract. Khoo therefore teaches the step of downloading only list of advertising resources

and guidelines in accordance with a viewer preference, wherein only the a subset of advertisements are downloaded (i.e. captured and stored) to the receiver.

Thomas discloses detecting pause in content usage, responsive to which interrupting the content temporarily to replace with an advertisement, wherein, the place in the content where the pause occurs, if the pause occurs at all is not determined by a content provider (i.e. use initiated pause). See Thomas: [0011].

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Picco in view of Khoo's and Thomas' teachings by obtaining a list of customized media, downloading selectively files from the customized list in accordance with receiver (i.e. viewer) preferences, and interrupt the content when a pause is detected to present the advertisement to the user. The motivation is to present useful information such as targeted advertisements in accordance with viewer's preferences over the duration of the pause.

Regarding Claim 2, the modified system comprises a method as stated above in Claim 1, wherein the set top box is operable to update content (see Picco: Col. 7, Lines 35-41) by storing selected local content as stated above Examiner further takes official notice that updating content can include the step of adding data thereby expanding the local database. It would have been obvious to one of ordinary skill in the art to further modify the system by combining the subset listing of advertising resources with advertising resources available on the receiver in order to expand the database at the local receiver.

Regarding Claim 3, the modified system comprises a method as stated above

in Claim 1, wherein collecting information includes monitoring the activities of the

user of the receiver (see Picco: Col. 11, Lines 9-13).

Regarding Claim 4, the modified system comprises a method as stated above

in Claim 3, wherein collecting information includes accumulating the collected data

(see Picco: Col. 11, Lines 9-13). This accumulation of user data reads on the

claimed developing a database of information about activities undertaken by the

user of the receiver.

Regarding Claim 5, the modified system wherein advertisements are stored in

a remote database and a subset of these ads are downloaded to user terminals for

selective storage based on user profile information as stated above. This reads on

the claimed selecting advertisements stored on the remote processor-based system

(ads from the head-end's database) based on information about the user of the

receiver (user profile). Khoo further discloses the step of receiving the subset listing

of advertising resources from a database of advertising resources. See Khoo:

[0031].

Regarding Claim 6, Khoo teaches the step of maintaining a customized list

that instructs the media clips to be downloaded in order for subsequent playback.

The customized list therefore reads on a local electronic guide (i.e. catalog) of

advertising resources to use to capture advertisements available on a remote

processor based system.

Regarding Claim 7, the modified system comprises a method as stated above in Claim 1, wherein the advertising has associated an associated content profile, which is compared to the user's profile for storage and playback (see Picco: Col. 7, Line 55 - Col. 8, Line 22). This reads on the claimed determining a characteristic of advertising and comparing it to information about the use of the receiver.

Regarding Claim 8, Picco discloses a method as stated above in Claim 1, wherein a user is operable to select television signals from satellite broadcasting for watching (Col. 5, Lines 10-16). The watching of satellite television signal reads on the claimed enabling a variety of content to be selected for play at any time. Khoo further discloses the step of storing a variety of content media on the content receiver to select for play at any time.

Regarding Claims 9 and 10, Picco discloses a method as stated above in Claim 1, wherein content has an expiration date (Col. 6, Lines 61-67) and a maximum number of times it may be viewed (Col. 7, Lines 1-2). This reads on the claimed controlling the number of times a user may access (i.e. view) the content that is stored on the receiver. Picco further discloses the step of automatically updating, including removing or overwriting (therefore replacing) electronic content. See Picco: column 10, lines 62-column 11, line 1).

Regarding Claim 11, see Claim 1 above.

Regarding Claims 12-19, see Claims 8, 3-7 and 9-10 respectively.

Regarding Claim 20, Picco discloses an article as stated above in Claim 11, further storing instructions that enable to receiver to catalog the advertisements it

has stored as stated above. This reads on the claimed automatically compiling a receiver- based database of advertising.

Regarding Claim 21, see Claim 1 above. It is inherent that such a computer-based terminal must run programming in order to function. This reads on the claimed shell.

Regarding Claim 22, Picco discloses a method as stated above in Claim 21, wherein the system is a television receiver (Co1. 5, Lines 12-16).

Regarding Claims 23-28, see Claims 9-10, 8, 3-4 and 6 above, respectively.

Regarding Claim 30, see Claim 6 above.

Regarding Claim 31, see Claim 28 above.

Regarding Claim 32, see Claim 28 above. Further, it is implicit that such television-based advertising must be in one or more known languages. This reads on the claimed advertisements specialized for a particular language.

With regards to claim 34, the pause in content usage that is detected is a user initiated pause in content usage. See Thomas: [0011]

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Picco et al. (U.S. Patent No. 6,029,045) in view of Khoo et al. (US Pre Grant Pub. 2002/0152465) and Thomas et al. (US PG Pub. 2003/0037068) as applied to claim 1 above, and further in view of Moshfeghi et al. (US Pat. 6,076,166).

With regard to claim 33, the modified system is silent on the step of collecting information about a characteristic of one of hardware and software that is present on the receiver.

Moshfeghi discloses a method of personalization of content (customization of web pages based on user's preferences as well as user's receiver characteristics) at user end by collecting information about the hardware and software (i.e. user's computer environment) on the receiver as part of user profile information.   See Moshfeghi: column 1, lines 42-58. Moshfeghi therefore discloses the step of selectively downloading files based on a receiver's characteristic.

It would have been obvious to further modify the system in view of Moshfeghi by collecting information about a characteristic of one of hardware and software so that the receiver maybe presented with resources that are based on the receiver's capabilities.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UR

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